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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,736	03/06/2002	Masayasu Suzuki	572.41312X00	5258

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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
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EXAMINER

DYKE, KERRI M

ART UNIT

PAPER NUMBER

2667

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,736

Applicant(s)

SUZUKI ET AL.

Examiner

Kerri M. Dyke

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2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 2-9 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/6/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: There were found to be numerous references missing from the description. The following are a representative sample. Please verify all references and make all necessary corrections.

- a. Figure 2.201-2
- b. Figure 3.301-2 and 301-3
- c. Figure 7.701-2 and 701-3
- d. Figure 8.801-2
- e. Figure 10.1001, 1002, and 1005
- f. Figure 14.1401

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 2-9 and 11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 1 and 10 are for devices. Claims 2-9 and 11 recite no further structure for the devices and therefore fail to further limit claims 1 and 10.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by TR45 “Data Service Options for Spread Spectrum Systems” (provided by applicant).
4. Claim 1 is for a radio base station apparatus. The structure recited in the claims is a control unit, a memory, and an inactivity timer. Figure 4 shows the control functions that inherently are carried out by a control unit. Page 2-7 lines 12-13 refers to the inactivity timer that inherently must be stored within memory. The remainder of claim 1 is a detailed functionality of the structure. An apparatus claim does not give patentable weight to recited functionality, see MPEP § 2113. See also *Hewlett-Packard Co. v Bausch & Lomb, Inc.* 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), where it is stated that “apparatus claims cover what a device *is* not what a device *does* (emphasis in original).”
5. Claims 2-9 recite additional functionality not structure for the apparatus of claim 1 and are thus also rejected because they fail to distinguish the structure from the prior art.
6. Claim 10 is for a mobile station apparatus. It also recites the structure of a control unit, a memory, and an inactivity timer. Figure 3 shows the control functions that inherently are carried

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out by a control unit. Page 2-3 line 3 refers to the inactivity timer that inherently must be stored within memory. The recited functionality of claim 10 is given no patentable weight for the same reasons recited in claim 1.

7. Claim 11 recites additional functionality not structure for the apparatus of claim 10 and is thus also rejected for failing to distinguish the structure from the prior art.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 12 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Koo (TSG Correspondence to Mr. Jean Alphonse).

10. Claim 12 is for a base station operating method. The base station having a control unit, memory, and an inactivity timer. The inactivity timer is set in accordance with application type, connection destination type, or the traffic pattern. Koo discloses a base station with an inactivity timer that is set according to the realm of the user. The realm is related to both the application and connection type. A base station inherently contains a control unit and memory.

11. Claim 13 is for a mobile station with the same structure and operating method as the base station in claim 12. Paragraph 5 discloses that the mobile station inactivity timer is set using the same method. A mobile station inherently contains the same structural components.

Allowable Subject Matter

12. Claims 2-9 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and to overcome the claim objections recorded above.

13. The following is a statement of reasons for the indication of allowable subject matter: Although there were several pieces of subsequent art with more specific details, it would appear that only the most basic idea of a variable inactivity timer had been introduced before applicant's priority date of May 16, 2001. Even the official version of the 3GPP2 variable inactivity timer was not published until December 6, 2001. The examiner went through meeting notes in order to find the basic details about the proposed timer. The 3GPP2 S.R0033 does not qualify as prior art, but it is being included in the list of references cited for the applicant's convenience.

Conclusion


14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The minutes of the January 15-19, 2001 meeting of the TSG-P are included to establish the first date on which the variable inactivity timer was mentioned. The TSG correspondence dated February 9, 2001 is included because the letter contains the text of the proposal set forth at the January TSG-P meeting. The cited IEEE articles each discuss the value of optimizing the inactivity timer. None, however, suggest dynamically changing the value based upon current operating conditions. The patent publications disclose a variable inactivity timer, but do not disclose the methods used to determine the value of the timer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kerri M. Dyke whose telephone number is (571) 272-0542. The examiner can normally be reached on Monday through Friday, 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on (571) 272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kmd


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2117 1/25/06